



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,812	09/26/2001	Jorg Gregor Schleicher	2060P	1207

7590 10/07/2005

SAWYER LAW GROUP LLP
P.O. Box 51418
Palo Alto, CA 94303

EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
----------	--------------

3639

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

1.0

Office Action Summary	Application No.	Applicant(s)	
	09/963,812	SCHLEICHER ET AL.	
	Examiner	Art Unit	
	Fadey S. Jabr	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

4/c

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the U.S. Patent serial no. that the applicant refers to on page 16 line 3 of the disclosure is omitted. Also, proper punctuation is required on page 5, line 10 of the disclosure.

Appropriate correction is required.

Claim Objections

2. Claim **10 and 27** are objected to because of the following informalities: The word *send* in line **2** of claim **10** and in line **13** of claim **27** is interpreted to mean *sent* and should be corrected including any subsequent recitations of the word. Also, in claim **10**, the claim ends with an *and* but fails to include additional wording, and therefore should be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **1, 17, 25, and 26** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For the purpose of expediting examination step (b)(ii) of claims **1, 17 and 26** and step (c) of claim **25**: periodically sending the subscribed to subscription-based content for serving the

Art Unit: 3639

subscription-based content is interpreted to mean merely sending subscription-based content to subscribers of the content.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-6, 9-14, 17-22, 26, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092.

As per **Claims 1, 9 and 17**, Ricci discloses a method for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

(a) enabling peer-to-peer file sharing of content by,

- (i) initiating on one client node a download of a particular content item served from the server node or another client node, and
- (ii) charging a fee based on a quantity of the content served (Para. 22, 53); and

(b) enabling decentralized downloads of subscription-based content by

- (i) allowing the client nodes to subscribe to one or more of the subscription-based content (Para. 57, 61),

Art Unit: 3639

- (ii) periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes (Para. 40).

Nonetheless, Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. However, Ferguson et al. teaches levying fees on content providers for transactions with the users (Col. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 2, 10, 18**, Ricci further discloses a method of providing direct marketing by sending marketing content to the client nodes from the server node as well as from other client nodes (Para. 65, lines 1-8). Ricci fails to disclose charging a fee to providers of the marketing content. However, Ferguson et al. teaches charging a fee to providers of the marketing content (Col. 14, lines 30-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging marketing content providers a fee as taught by Ferguson et al. because charging marketing content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 3, 11, and 19**, Ricci further discloses a method enabling client nodes to become affiliate servers that deliver content to other client nodes (Para. 30). Ricci fails to disclose paying owners of the affiliate servers a percentage of the fee charged for serving the

Art Unit: 3639

files. However, Ferguson et al. teaches paying the user of the service (Col. 9, lines 2-9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include paying users of the affiliate servers a portion of the fee charged for serving the files as taught by Ferguson et al. because paying owners of the affiliate servers would increase retention of the affiliate server owners.

As per **Claims 4-6, 12-14, and 20-22**, Ricci further discloses a method including the steps of charging a fee from a user of the initiating client node for the download of the fee-based content (Para. 22, 53). Ricci fails to disclose charging a fee from a provider of the free content for serving the free content. However, Ferguson et al. teaches charging content providers a fee (Col. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging content providers a fee for serving the free content as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 26, and 27**, Ricci discloses a system for generating revenue in a peer-to-peer file delivery network, the network including at least one server node and multiple client nodes, the method comprising the steps of:

- means for enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node (Para. 18), and
- wherein a fee is charged based on a quantity of the content served (Para. 22, 53);

Art Unit: 3639

- means for providing direct marketing to client nodes such that marketing content is send to the client nodes from the server node as well as from other client nodes (Para. 65, lines 1-8),
- means for enabling client nodes to become affiliate servers that deliver content to other client nodes (Para. 30),

Nonetheless, Ricci fails to disclose:

- means for enabling decentralized downloads of subscription-based content that the client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes;
- owners of the affiliate servers are paid a percentage of the fee charged for serving the files.
- a fee is charged to providers of the marketing content.

However, Ferguson et al. teaches users of the system receive periodic updates; levying fees on content providers for transactions with the users; paying users of affiliate servers for serving the files, and finally teaches charging marketing content providers a fee (Col. 15, lines 7-11; Col. 4, lines 53-60; Col. 14, lines 30-31; Col. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include providing periodic updates to users, levying fees on content providers, and to pay owners of affiliate servers for serving the files as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service. Also,

Art Unit: 3639

paying owners of affiliate servers because paying owners of the affiliate servers would increase retention of the affiliate server owners.

7. Claims **7, 8, 15, 16, 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Ferguson et al., U.S. Patent No. 5,819,092 as applied to claims **1, 9, and 17** above, and further in view of Applicants admission of the prior art.

As per **Claims 7, 15, and 23**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per click. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per click as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per click is admitted prior art.

As per **Claims 8, 16, and 24**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per acquisition. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per acquisition as disclosed by Applicant. By Applicant's own admission, the feature of

Art Unit: 3639

charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

As per **Claim 25**, Ricci fails to disclose a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network, each of the client nodes affiliated with a user account, the method comprising the steps of:

- (b) allowing the client nodes to subscribe to one or more of the content files (Para. 57, 61);
- (c) periodically delivering the particular content files to the respective clients nodes that subscribed to the content files (Para. 40);
- (f) charging the user accounts of the client nodes that received fee-based subscription content files (Para. 22, 53).

Nonetheless, Ricci fails to disclose:

- (a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files;
- (d) charging the content provider a fee for delivering the content files to the client nodes over the network.

However, Ferguson et al. teaches receiving content files from content providers; and also charging content providers a fee for serving the content files to the users (Col. 4, lines 53-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and include receiving content files from content

Art Unit: 3639

providers and charging content providers a fee for serving the files as taught by Ferguson et al. because charging a variety of content providers a fee would greatly increase profitability of the file sharing service. Ricci and Ferguson et al. nonetheless fail to disclose charging the content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging content provider a fee based on the number of users to access the content as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3639

9. Claims **1-27** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **16 and 17** of copending Application No. 09/814319 in view of Ferguson et al., U.S. Patent No. 5,819,092.

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims **16 and 17** of Application No. 09/814319 recite:

A peer-to-peer file delivery network, comprising:

- at least one server node;
- multiple client nodes coupled to the server node over the network, each of the client nodes running a client application, wherein the client application works and operates in conjunction with the server node to enable secure and reliable peer-to-peer file sharing between two client nodes by,
enable secure and reliable peer-to-peer file sharing between two client nodes by,
- generating account information for a user of each client node, including a digital certificate, in response to a registration process, wherein the digital certificate includes a private key and a public key,
- in response to a file being selected for publication on a first client node by a first user,
 - generating and associating a digital fingerprint with the file,
 - generating a bitstream ID for the file and including the bitstream ID in the fingerprint, and
 - using the user's private key to generate a digital signature from the

file and including the digital signature in the fingerprint.

adding an entry for the file to a search list of shared files on the server

- node and storing the fingerprint on the server,
 - in response to a second client node selecting the file from the search list on the server node, automatically transferring the file from the first client node directly to the second client node, and
- authenticating the file by the second client node by generating a new bitstream ID, comparing the new bitstream ID to the bitstream ID in the fingerprint stored on the server, and using the user's public key to decrypt the digital signature to determine the authenticity and reliability of the file and publisher.

The network of claim 17 wherein the client application operates in conjunction with the server node to enable subscription-based decentralized file downloads to the client nodes by

- allowing the client nodes to subscribe with the server node to periodically receive copies of one of the files,
- when providing a current subscribing client node with the file, locating the closest client node containing the file, and
- transferring the file from the closest node directly to the current subscribing node, thereby efficiently utilizing bandwidth.

Claims 16 and 17 of Application No. 09/814319 differs since it further recites additional claim limitations including generating account information for a user of each client node, including a digital certificate; authenticating the file by the second client node by generating a new bitstream

Art Unit: 3639

ID; and allowing client nodes to subscribe with the server node to periodically receive copies of one of the files. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 by removing the limitations directed to generating account information, authenticating a file using a bitstream, and allowing client nodes to subscribe with the server node resulting generally in the claims of the present application since the claims of the present application and the claims recited in Application No. 09/814319 actually perform a similar function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before.

Also, claims **16 and 17** of Application No. 09/814319 differ since they fail to recite a method for charging a fee to providers and users of the subscription-based content, either for serving the subscription-based content to the users or for receiving the content. Ferguson et al. teaches a method for levying fees against both users and content providers in an online system (Col. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 and include the method of charging a fee to providers and users of the subscription-based content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability for the service.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yau et al., Pub. No. US2002/0066026 A1
- b. Kauffman et al., US Patent No. 6,260,040 B1

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

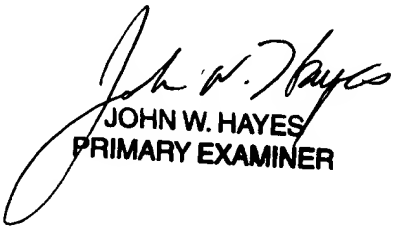
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
Art Unit 3639

FSJ


JOHN W. HAYES
PRIMARY EXAMINER